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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/713,098 11/14/00 ZLOT

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HM12/1024

EXAMINER

FWOIL DT, G	
ART UNIT	PAPER NUMBER

1644  
DATE MAILED:

10/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/713,098**

Applicant(s)  
**Zlot et al.**

Examiner  
**G. R. Ewoldt**

Art Unit  
**1644**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 17, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

**DETAILED ACTION**

1. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Dr. Gerald Ewoldt, Art Unit 1644, Technology Center 1600.
2. Applicant's election of Group II, Claims 11-15 in Paper No. 7, filed 8/21/01, is acknowledged. Upon reconsideration, however, the previous restriction requirement and election are vacated. A new restriction follows. The Examiner apologizes for any inconvenience or delay.
3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
  - I. Claims 1-10 drawn to a polynucleotide encoding the polypeptide of SEQ ID NO:2, expression vector, host cell, and kit, classified in Class 435, subclasses 252.3, 320.1, and 810 and Class 536, subclass 23.6.
  - II. Claims 1-10 drawn to a polynucleotide encoding the polypeptide of SEQ ID NO:5, expression vector, host cell, and kit, classified in Class 435, subclasses 252.3, 320.1, and 810 and Class 536, subclass 23.6.
  - III. Claims 1-10 drawn to a polynucleotide encoding the polypeptide of SEQ ID NO:7, expression vector, host cell, and kit, classified in Class 435, subclasses 252.3, 320.1, and 810 and Class 536, subclass 23.6.
  - IV. Claims 11, 12, and 15, drawn to a binding compound specific for the polypeptide of SEQ ID NO:2 and a kit, classified in Class 530, subclasses 350 and 387.1, and Class 536, subclass 23.6.
  - V. Claims 11, 12, and 15, drawn to a binding compound specific for the polypeptide of SEQ ID NO:5 and a kit, classified in Class 530, subclasses 350 and 387.1, and Class 536, subclass 23.6.
  - VI. Claims 11, 12, and 15, drawn to a binding compound specific for the polypeptide of SEQ ID NO:7 and a kit, classified in Class 530, subclasses 350 and 387.1, and Class 536, subclass 23.6.

VII. Claims 13-14, drawn to method of forming a complex with a binding protein specific for SEQ ID NO:2, classified in Class 530, subclass 350+.

VIII. Claims 13-14, drawn to method of forming a complex with a binding protein specific for SEQ ID NO:5, classified in Class 530, subclass 350+.

IX. Claims 13-14, drawn to method of forming a complex with a binding protein specific for SEQ ID NO:7, classified in Class 530, subclass 350+.

X. Claims 16-18, drawn to a polypeptide comprising SEQ ID NO:2 classified in Class 530, subclasses 300 and 326.

XI. Claims 16-18, drawn to a polypeptide comprising SEQ ID NO:5 classified in Class 530, subclasses 300 and 326.

XII. Claims 16-18, drawn to a polypeptide comprising SEQ ID NO:7 classified in Class 530, subclasses 300 and 326.

XIII. Claims 19-20, drawn to method of modulating the physiology of a cell with a DC-STAMP antagonist, classified in Class 530, subclass 350+.

XIV. Claims 19-20, drawn to method of modulating the physiology of a cell with a DC-STAMP agonist, classified in Class 530, subclass 350+.

XV. Claims 19-20, drawn to method of modulating the physiology of a cell with a DSP-1 antagonist, classified in Class 530, subclass 350+.

XVI. Claims 19-20, drawn to method of modulating the physiology of a cell with a DSP-1 agonist, classified in Class 530, subclass 350+.

4. Inventions I-VI, and X-XII are different products. They are distinct because their structures and/or modes of action are different. The polynucleotides of Inventions I-III are related to the polypeptides of Inventions X-XII by virtue of encoding same. However, nucleic acids and polypeptides are physically and functionally distinct chemical entities. The polypeptides of X-XII and IV-VI comprise different proteins. The polynucleotides of I-III encode different proteins. Therefore, the inventions are patentably distinct.
5. Inventions IV-VI and VII-IX are related as products and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)).

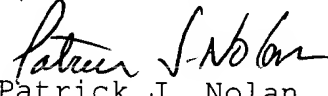
In the instant case, the product as claimed can be used in materially different processes, such as for antibody production.
6. The methods of Claims VII-IX, forming complexes are unrelated to the methods of Claims XIII-XVI, modulating cell physiology.
7. The methods of Claims XIII and XIV employ different reagents than do the methods of Claims XV and XVI.
8. The methods of Claims XIII and XIV are mutually exclusive.
9. The methods of Claims XV and XVI are mutually exclusive.
10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
11. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

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12. Any inquiry concerning this communication from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

G.R. Ewoldt, Ph.D.  
Patent Examiner  
Technology Center 1600  
October 22, 2000

  
Patrick J. Nolan, Ph.D.  
Primary Examiner  
Technology Center 1600